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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/828,417 03/28/97 MIRASAKI

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EXAMINER

QM32/0509

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ART UNIT

PAPER NUMBER

3713

DATE MAILED:

05/09/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/828,417

Applicant(s)

Mirasaki et al.

Examiner
John M. Hotaling II

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3713



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Mar 12, 2001
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-28, 31, and 33-44 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-28, 31, and 33-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirements.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

MARK SAGER

PRIMARY EXAMINER

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other: _____

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DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 23-28, 31, and 33-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murata et al. '743 (hereinafter Murata '743) in view of Lowe et al '401, Best '073, Best '152 and Cookson et al '950. The rejection contained in the previous office actions are relevant and incorporated herein. The object of the primary reference, Murata '743, is to provide a sophisticated play-by-play announcement in response to each scene or operation of the game, realistically and without hindering the game development as disclosed in column 1 lines 40-60. This is accomplished by having a storage portion operable to store data for each of a plurality of vocal sound groups, each vocal sound group is associated with a game scene. The controller designates data of a vocal sound group suitable to the produced new scene which make it possible to generate vocal sounds suitable for game developments, which consequently provides an improved realistic atmosphere. Murata '743 provides an example of his system using a baseball game as outlined in columns 3 and 4. In this example a baseball game contains four scenes; a batting scene, a fielding scene, a changing-over scene, and a game set scene. Each of these scenes is associated with a group of vocal sounds and these vocal sounds can be placed together in any

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manner that accurately provides a play-by-play commentary with respect to the play of the game. Murata '743 gives as an example for the batting scene a combination of the vocal sounds associated with that scene; "STRIKE, BATTER OUT, THREE MEN OUT". Murata '743 also give similar examples for the remainder of the example scenes. Murata '743 discloses in columns 1 and 2 a play-by-play announcement corresponding to the proceedings of the game by specifying the adequate terms from a storage portion expressing a word in connection with the game, the storage portion operable to store a plurality of vocal sound groups and a controller operable to produce a new game scene on the monitor in accordance with a game program which are the commands that take the specific sounds saved in a database and output them on a output device. In addition, each data part is assigned a specified address which is stored in the storage portion, or data base, and consists of a data region and a reference region. Column 4 lines 25-70 discloses that the CPU designates an appropriate vocal sound group, which is a command, to be used in the play-by-play announcement in accordance with the development of the game and converts and outputs the data which can also be stored as groups of sounds. Column 5 line 17 through column 6 line 24 disclose the use of alternate phrases based on the play of the game such as when a strike is thrown the program switches or jumps from database to database based on the play of the game based on a predetermined procedure and database replacement condition, player action and/or command data. Murata '743 discloses on page 4 line 14 through page 5 line 12 a play-by-play announcement corresponding to the proceedings of the game by specifying the adequate terms from a glossary of terms corresponding to the proceedings of the game, and a

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database of the on the spot broadcasting terms with a voice output means which converts the stored data into and audible speed voice. The glossary of terms or the on-the-spot-broadcasting terms are data regions which are stored vocal sound data on databases and are well known in the art. Murata '743 discloses in column 1 line 49 through column 2 line 5 a processing section or manipulator for monitoring the state of the game, a play-by-play announcement for a plurality of phrases or vocal sound groups, a controller to produce a new game scene and designate data for vocal sound suitable to the produced new scene. The plurality of phrase databases and plurality of phrases relative to a predetermined condition that the processing section selects from is disclosed on column 4 line 50 through column 6 line 25 where the plurality of databases are the vocal sound data storage portion. These data regions which store vocal sound data are databases. Column 4 lines 25-32 and column 7 lines 1-11 disclose the sound manipulation and output of the vocal sounds. Murata '743 discloses all of the claimed invention as but lacks in disclosing a feature that suspends commentary, provide alternate language commentary, same size databases, and wild cards, switching from database to database based on a predetermined event or player action replacement condition designated by a player. In an analogous machine Lowe et al. '401, column 2 lines 5-12 discloses that a game may store the video and audio material using laser disk technology, CD-ROM, computer hard drive or other storage means allowing random access retrieval. Column 3 lines 20-35 disclose that the laser video disc storage device provides for storage and retrieval of audio information. Column 5 line 55 through column 6 line 10 discloses that the audio storage and retrieval means can utilize several different formats, and in particular

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the video laser disc format there may be two audio tracks for one video track and that additional audio tracks can be on other video laser discs, CD's, or on the hard drive that are run in sync with the main program. Column 7 lines 10-31 discloses the timing and control of all video and audio sequences, that the video and audio inserts database stores information on all inserts that are available to the video control logic. Column 11 lines 1-21, teaches that it is known to line up the audio and video, and to mute the play by play commentary and replace it with an audio insert which may be silence or a alternate sound such as music or a commercial. One skilled in the art would understand the teachings of Lowe et al. '401 because of the use of speech, commentary, or an alternate sound associated with a game machine. Cookson discloses on column 1 lines 5-15 that the invention relates to the generation of audio signals during play of a software carrier and more particularly to a technique by which multiple dialog languages may be recorded on separate audio tracks. Column 2 lines 25-30 disclose that the invention is not limited to a particular medium or only to the distribution of motion pictures. Column 3 lines 25-30 disclose that it is necessary for the player to control his player for the desired language to be played. Column 12 line 30 through column 13 line 10 disclose that the special software may be game software. Column 37 claim 1 discloses a system for controlling play of the audio tracks of a digital software carrier including a dialog language and a switching master to switch to a different audio track. A predetermined event and a replacement condition designated by a player could include the player's choice in language to be used in the video game prior to the play of the video game thereby switching to an alternate language track or database. The art benefits from the Best patents in that

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automatic or player selected switching from database to database will result in a games that will have multiple story plots and will not be predictable. Best '073 discloses the use of alternate phrase databases on figure 11 and column 11 lines 45-50 that may be stored on a disk or in memory, can be used based on the selection of a player which is player action or based on a switching command from the machine which is also a predetermined procedure. Best '152 in column 10 lines 39-70 and column 11 lines 1 and 2 disclose that the audio cue commands are of a fixed length record which are stored into a cue table and that these audio clips where a predetermined procedure for a branch point may abandon some audio cues and select others. The branch point is associated with the progression of the events in the game. The art benefits from the Best patents in that automatic or player selected switching from database to database will result in a games that will have multiple story plots and will not be predictable. The use of two announcers is well known and is an obvious matter of choice well within the capabilities of those skilled in the art since it is common place to have multiple sports announcers for commenting on a game. It would be obvious to one of ordinary skill in the art at the time of the invention to combine the above references the obvious motivation to combine the references is that all of the references are related to the audio placement with respect to the action occurring in the video games and all of the references teach a form of inserting the proper sounds and/or commentary based on the play of the game. Furthermore, Murata '743 discloses that the sound generator generates sounds suitable for a scene based on designated data and that a plurality of vocal sounds

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having the same word but different intonations and the program is able to select a proper vocal sound group according to the circumstance in the game.

Remarks

2. The objections of the previous office action have been overcome to the satisfaction of the examiner.

Response to Arguments

3. Applicant's arguments filed 3/12/01 have been fully considered but they are not persuasive. In addition, any argument not specifically addressed in the response to arguments section can be found in the above rejection.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this instance the obvious motivation to combine the references is that all of the references are related to the audio placement with respect to the action occurring in the video games and all of the references teach a form of inserting the proper sounds and/or commentary based on the play of the game. This motivation obviates the applicant's objection to improper hindsight reasoning.

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In response to applicant's argument that since the references come from different subclasses that they are non-analogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, all of the references are related to the audio placement with respect to the action occurring in the video games.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the instant application being spontaneous or creative) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). With respect to the salient or critical distinction of the instant application being spontaneous or creative and that Murata does not have this feature the examiner would like to point out that Murata does indeed provide a varying commentary in accordance with the play of the game ("...the message announced adjusts to the nature of the event...") as indicated in the above rejection.

In response to applicant's argument that the examiner has combined an excessive number of references, reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention. See *In re Gorman*, 933 F.2d 982, 18

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USPQ2d 1885 (Fed. Cir. 1991). In this instance please see above where the references are all related and the motivation to combine the references is explained.

With respect to the applicant's request to remove the finality of the last office action is denied. The claims that stood previously were subject to a final rejection because all the claims were drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. In the instant application new claims have been drawn with respect to the invention and therefore this action is non-final.

Citation of Pertinent Art


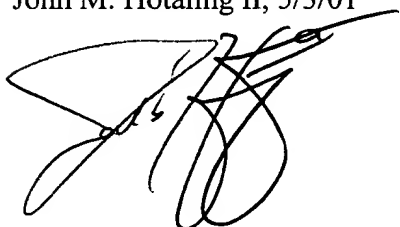
4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Tong '994 discloses a interactive computer controlled doll, Chu '019 discloses multiple audio signals in accordance with game play, Rose '602 discloses a talking doll responsive to an external signal

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Hotaling II whose telephone number is (703) 305-0780. The examiner can normally be reached Monday- Friday from 7:30 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor can be reached at (703) 308-4119.

John M. Hotaling II, 5/3/01



MARK SAGER
PRIMARY EXAMINER